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Supreme Court, U.S.
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IN THE

Supreme Court of the United States

No. 71—441

MICHAEL EDWARD BENET JONES and
IMPERIAL CHEMICAL INDUSTRIES LIMITED, *Petitioners,*

v.

HERWARD A. VOGEL and MINNESOTA MINING AND
MANUFACTURING COMPANY, *Respondents*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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IN THE

Supreme Court of the United States

No. 71—

MICHAEL EDWARD BENET JONES and
IMPERIAL CHEMICAL INDUSTRIES LIMITED, *Petitioners,*

v.

HERWARD A. VOGEL and MINNESOTA MINING AND
MANUFACTURING COMPANY, *Respondents*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Petitioners respectfully pray that a Writ of Certiorari issue to review the decree or judgment of the Court of Appeals for the Third Circuit entered on May 17, 1971.

OPINIONS OF THE COURTS BELOW

The opinion of the United States Court of Appeals for the Third Circuit dated May 17, 1971 is reported at 443 F.2d 257. A copy of this opinion is appended to this petition (Appendix, page 1a).

The opinion of the United States District Court for the District of New Jersey, dated October 20, 1970, is not officially reported but is unofficially reported at 167 U.S.P.Q. 618. A copy of this opinion is also appended to this petition (Appendix, page 9a).

JURISDICTION

The judgment or decree of the Court of Appeals, review of which is sought, is dated May 17, 1971 and was entered on May 17, 1971 (Appendix, page 6a). The Court of Appeals Order denying rehearing (Appendix, page 7a) is dated June 28, 1971.

This Court has jurisdiction to issue the writ now requested under Title 28, United States Code, Section 1254(1).

QUESTION PRESENTED

Does the United States District Court for the District of New Jersey have personal jurisdiction over a non-resident alien, who lacks even "minimum contacts" with that District, for purposes of proceedings under 35 U.S.C. § 24 in connection with patent interferences otherwise pending solely in the United States Patent Office in the District of Columbia?

The New Jersey District Court below held that it did *not* have personal jurisdiction over petitioners, both of whom are non-resident aliens, because neither alien was residing or within the district of New Jersey

and because New Jersey was not the district wherein testimony was to be taken for use in the Patent Office as required by 35 U.S.C. 24. The Third Circuit Court of Appeals reversed, its opinion holding that such non-resident aliens are subject to personal jurisdiction in *any* and *every* judicial district of the United States, even though they have never had any contact or any connection whatever with the forum district. Under this decision, merely because they have become involved in an interference in the Patent Office in the District of Columbia, non-resident aliens can now be subject to legal process in *any* district court *anywhere* in the land.

STATUTES INVOLVED

35 U.S.C. 24 provides:

§ 24. Subpoenas, witnesses

> The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.
>
> Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.
>
> A judge of a court whose clerk issued a subpoena may enforce obedience to the process or

punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

28 U.S.C. 1391(d) provides:

Venue generally

(d) An alien may be sued in any district.

Title 35 U.S.C. Sections 104, 119, 146 and 293 are set forth in the Appendix, page 10a-13a.

STATEMENT OF THE CASE

The Parties and Nature of the Action

Petitioner Jones and Respondent Vogel are parties to two interference proceedings Nos. 96,167 and 96,500 currently pending in the United States Patent Office.[1] Petitioner Imperial Chemical Industries [ICI] and respondent Minnesota Mining & Manufacturing Co. [Minnesota] are assignees of the patent rights of Jones and Vogel, respectively.

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[1] Interferences are statutory administrative proceedings in the United States Patent Office authorized by 35 U.S.C. 135. The sole purpose of the administrative tribunals of the Patent Office in such proceedings is to determine the first inventor between rival claimants. See *Jacobs* v. *Sohl*, 280 F.2d 140, 144 (CCPA 1960) The administrative interference proceedings in the Patent Office are governed by the United States Rules of Practice in Patent Cases. (These rules are in the Code of Federal Regulations, Part 1 of Title 37, Patents Trademarks and Copyrights).

Alleging jurisdiction under 35 U.S.C. 24, respondents (who are each U. S. citizens) sought to initiate discovery proceedings in the United States District Court for the District of New Jersey against:

(1) Petitioner Jones [Jones], a subject of the Queen of Great Britain who resides in England and who neither resides nor is within the State of New Jersey; and

(2) Petitioner Imperial Chemical Industries Ltd. [ICI], a British corporation having its principal offices in London, England, which has no offices or regular place of business in New Jersey, and which neither resides nor is within the State of New Jersey.

Copies of the papers filed by respondents in the District Court were mailed to Jones' patent counsel of record in the interference in Washington, D. C. and to ICI in England.[2]

Respondents' purpose was to seek from Jones and ICI a sweeping production of documents all of which are in England and, like Jones and ICI, have never been within, nor had any contact whatever with, the District of New Jersey.

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[2] Copies of the same papers were also delivered to ICI America Inc., a Delaware corporation doing business in New Jersey. ICI America is a separate entity from petitioner ICI and has no interest in the patent applications or the interferences. The Third Circuit Court of Appeals specifically held that *"ICI America's existence has no relevance to our decision"* and made no further reference to it. (Appendix, page 3a).

No testimony was to be taken in New Jersey,[3] there was no discoverable material in New Jersey nor even anyone whatever having custody or access to any discoverable information or material within New Jersey.

The Proceedings Below

After full briefing by both parties, including the submission of affidavits by both parties, and after full oral argument, the District Court granted petitioner's motion to dismiss because of lack of personal jurisdiction and failure to meet the other requirements of 35 U.S.C. 24, stating:

> "This Court is without jurisdiction under 35 U.S.C. § 24, over the movants herein, since *neither of the movants is 'residing or being within such district', both being subjects of and residing in Great Britain and this not being the district wherein testimony is to be taken*". (Appendix, page 10a) [4]

The Court of Appeals for the Third Circuit reversed holding that "When a non-resident alien is a party to a patent interference, the other party may seek discovery of documents from him in *any* district". The Court of Appeals itself characterized this result as "an apparent *anomaly*". (Appendix, page 5a)

---

[3] The first sentence of 35 U.S.C. 24 states:

> "The clerk of any United States court for *the district wherein testimony is to be taken for use in any contested case in the Patent Office,* shall, upon the application of any party thereto, issue a subpoena for any *witness residing or being within such district,* commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena."

[4] Emphasis supplied throughout unless otherwise indicated.

Petitioners sought rehearing *en banc* pointing out that the Court of Appeals' decision was in conflict with the decisions of this Court which hold that fundamental concepts of due process preclude subjecting a party to a judgment *in personam* without certain minimum contacts with the forum district. *International Shoe Company* v. *State of Washington,* 326 U.S. 310, 316 (1945); *Hanson* v. *Denckla,* 357 U.S. 235, 251 (1958). Petitioners also pointed out that the Court of Appeals' decision was in conflict with the statutes 35 U.S.C. 146 and 35 U.S.C. 293 (Appendix, page 12a-13a) which provide that *only* the United States District Court for the District of Columbia shall have jurisdiction over non-resident aliens who are seeking or have acquired U. S. patent rights. On June 28, 1971, the Court denied the petition for rehearing.

REASONS FOR GRANTING THE WRIT

The Decision of the Court of Appeals That the United States District Court for the District of New Jersey Has Personal Jurisdiction Over a Non-resident Alien Who Lacks Even Minimum Contacts With That District Is a Denial of Due Process and in Direct Conflict with the Decisions of This Court.

The decision of the Third Circuit, reversing the District Court and holding in effect that *every* District Court in the United States, its Territories and Possessions, has personal jurisdiction over *every* non-resident alien who merely files a patent application and becomes involved in an interference, wholly within the Patent Office (in the District of Columbia), is in conflict with the decisions of this Court. Under the Court of Appeals' decision, non-resident aliens need not even have any "minimum contacts" with the forum district for the Federal Courts of that district

to assert personal jurisdiction over the non-resident alien.

In *International Shoe Co.* v. *State of Washington,* 326 U.S. 310, 316 (1945), this Court said:

> ". . . *due process requires* only that in order to subject a defendant to a judgment in personam, if he be not present within the territory of the forum, he *have certain minimum contacts* with it such that the maintenance of the suit does not offend 'traditional notions of fair play and substantial justice' ".

More recently, in *Hanson* v. *Denckla,* 357 U.S. 235, 251 (1958), this Court observed the evolution of the requirements for personal jurisdiction from *Pennoyer* v. *Neff,* 95 U.S. 714 (1877), to the flexible standard of *International Shoe,* and expressly cautioned:

> "But *it is a mistake to assume that this trend heralds the demise of all restrictions on the personal jurisdiction* of the state courts * * * * However minimal the burden of defending in a foreign tribunal, *a defendant may not be called upon to do so unless he has had the 'minimal contacts'* with that State that are a prerequisite to its exercise of power over him."

The Court of Appeals did not heed the due process requirement of "minimum contacts" announced in *International Shoe* and ignored the warning of this Court in *Hanson* v. *Denckla.* Its decision in effect substituted a "*no* contacts" standard in direct conflict with both decisions of this Court.

The Third Circuit's statement that the "apparent anomaly" of their holding is a "consequence of the venue statute applicable to aliens" is a makeweight

which cannot satisfy the requirements of due process. The venue statute applicable to aliens, 28 U.S.C. 1391(d) is simply inapplicable to the essential requirement of personal jurisdiction. Venue is a doctrine of convenience, *not* jurisdiction. It is concerned with which court, of those courts that possess requisite personal and subject matter jurisdiction, may hear a specific suit in question. See 1 *Moore, Federal Practice,* 1317 (2nd Ed. 1964).

The Decision Below Is Also in Conflict With the Statutes

The Court of Appeals itself acknowledged the "apparent anomaly" of its holding that when a non-resident alien is a party to a patent interference, the other party may seek discovery of documents from the alien in *any* District Court *anywhere* in the United States.

In every instance that Congress has dealt with the question of non-resident aliens who seek or obtain U. S. patents, it has provided *only* that the United States District Court for the District of Columbia shall have jurisdiction.

Thus, 35 U.S.C. 146 (Appendix, page 12a) which permits a patent applicant who is dissatisfied with a decision of the Patent Office in a patent interference proceeding (as is here involved) to bring an action in a district court provides in the pertinent part:

> "36 U.S.C. 146 Civil Action in case of interference
>
> * * * *
>
> If there be . . . *an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction* . . . ."

This statute specifically covers non-resident aliens who have filed U. S. patent applications, which have become involved in interferences in the Patent Office. *Only* the United States District Court for the District of Columbia is given such jurisdiction over non-resident aliens.

Congress has likewise specifically provided the District of Columbia District Court exclusive jurisdiction over non-resident patentees in 35 U.S.C. 293 (Appendix, page 13a) which states:

> "§ 293. Nonresident patentee; service and notice
>
> Every patentee not residing in the United States may file in the Patent Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, *the United States District Court for the District of Columbia shall have jurisdiction* and summons shall be served by publication or otherwise as the court directs. The Court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally wihin the jurisdiction of the court."

Because of the express statutory requirements of 35 U.S.C. 104 (Appendix, page 10a), non-resident aliens, such as petitioners here, *cannot* rely upon any "knowledge" or "use" or any other "activity" in any foreign country to establish a date of invention.[5]

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[5] By virtue of 35 U.S.C. §§ 104 and 119 petitioner Jones is restricted in the patent interferences to the filing date of his British application.

Hence, only in unusual circumstances peculiar to the particular Patent Office interference proceedings is discovery from a non-resident alien necessary.

It is not only consistent with the due process requirement of "minimum contacts" and the statutory provisions Congress has enacted in 35 U.S.C. §§ 146 and 293, but also in the interest of judicial economy to have all of the extraordinary discovery of non-resident aliens, who are parties to Patent Office interference *proceedings in the District of Columbia, regulated by the United States District Court for the District of Columbia.*

Because of the Far-Reaching, Adverse Consequences of the Decision of the Court Below to Both Non-resident Aliens and to Efficient Judicial Administration, This Court Should Exercise Its Power of Supervision

The decision below has far-reaching consequences to every alien, who merely because he seeks U. S. patent rights (in most cases, as in this, under International Treaty[6]) by filing an application in the Patent Office in the District of Columbia can now be brought into any district court anywhere in the land. The effect of this decision is to subject non-resident aliens to enormous potential harassment (at a time when our government seeks the cooperation of foreign Patent Offices[7]) and place an entirely novel and unnecessary burden on all district courts throughout the land.

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[6] 35 U.S.C. §§ 104 and 119; International Convention for the Protection of Industrial Property; 53 Stat. 1748 (Appendix, pages 10a-11a)

[7] Patent Cooperation Treaty signed in Washington, D.C. on June 19, 1970.

As recently as May 3, 1971, this Court in *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation,* — U.S. — No. 338 — October Term 1970, 28 L. Ed. 2d 788, expressed acute concern with the inordinate amount of judicial time required by patent cases. At a time when the burdens on our judicial systems have reached overwhelming proportions, the transcending public interest in efficient judicial administration requires this Court to examine the decision below and its effects.

Indeed, it requires little imagination to foresee the decision of the Court of Appeals as precedent for every district court having in personam jurisdiction over every non-resident alien who is transacting business before any of the multitude of administrative agencies of the Federal Government. Unpalatable potential mischief could thus be worked on an already overburdened Federal judiciary.

Unless this Court exercises its power of supervision, obviously undesirable consequences to both non-resident aliens who merely submit applications to the Patent Office in the District of Columbia and to the numerous district courts which will be called upon to order and regulate discovery can only result.

CONCLUSION

The Court of Appeals, in reversing the District Court, decided a federal question in conflict with the applicable decisions of this Court. The "minimum contacts" needed to satisfy the requirements of due process and establish personal jurisdiction of the New Jersey District Court over each of the wholly British petitioners are utterly lacking. For this as well as each

of the foregoing reasons, this petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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APPENDIX

APPENDIX

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 19,374/5

HERWARD A. VOGEL AND MINNESOTA MINING AND MANUFACTURING COMPANY, a corporation of Delaware,

v.

MICHAEL EDWARD BENET JONES AND IMPERIAL CHEMICAL INDUSTRIES LIMITED, a corporation of Great Britain

HERWARD A. VOGEL, *Appellant in* No. 19,374

MINNESOTA MINING AND MANUFACTURING COMPANY, a corporation of Delaware,
Appellant In No. 19,375

(D. C. Civil Action No. 1059-70)

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY

Argued April 19, 1971

Before SEITZ, ADAMS and ROSENN, *Circuit Judges*

Opinion of the Court

(Filed May 17, 1971)

ADAMS, *Circuit Judge.*

This case presents another chapter in the continuing saga regarding the authority of federal district courts to order discovery in patent interference proceedings pursuant to 35 U.S.C. § 24.[1]

[1] *See* In re Natta, 259 F. Supp. 922 (D. Del. 1966); Natta v. Zletz, 397 F.2d 615 (7th Cir. 1967); In re Natta, 388 F.2d 215 (3rd Cir. 1968); Natta v. Hogan, 392 F.2d 686 (10th Cir. 1968); Babcock & Wilcox Co. v. Foster Wheeler Corp., 432 F.2d 385 (3rd Cir. 1970). For a description of the Patent Office proceedings in an interference, see In re Natta, 388 F.2d at 216.

Vogel, a Minnesota resident, and Jones, a British subject and resident, are the two named parties to Patent Office Interferences No. 96,167 and No. 96,500. The real parties in interest, however are their respective assignees, Minnesota Mining and Manufacturing Company ("3M"), a Delaware corporation whose principal office is at Saint Paul, Minnesota, and Imperial Chemical Industries, Limited ("ICI"), a British corporation. The dispute between 3M and ICI concerns moldable plastic compositions called polyarylsulfones. 3M filed its two patent applications on May 13, 1963; six months later ICI filed the single patent application involved in both interferences. Since ICI relied on its prior British filings of November 6, 1962 and March 13, 1963 (see 35 U.S.C. § 119), ICI was declared by the Patent Office to be the senior party in Interference No. 96,500 but 3M remained the senior party in Interference No. 96,167.[2]

3M initiated the discovery proceedings here in question on August 6, 1970, in the United States District Court for the District of New Jersey, by filing a "Notice of Ancillary Proceedings for Discovery Under 35 U.S.C. § 24," and a request for production of documents by Jones and ICI.[3] Copies of the Notice and the request for documents were

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2 The Patent Office decided on September 8 and October 13, 1970, that no testimony period whatever would be permitted in Interference No. 96,167. In such circumstance, any discovery sought by either party pursuant to Interference No. 96,167 would appear to be of irrelevant matters, and therefore improper. See Fed. R. Civ. P. 26(b); *cf. Babcock & Wilcox, supra* at 388; *In re Natta*, 388 F.2d at 220. Yet, conceivably the subject matter of Interference No. 96,167 might be so interwoven with that of No. 96,500 that the requirement of relevance can be met by the party seeking discovery. Accordingly, the motion to dismiss as moot will be denied.

3 3M's testimony period in the Patent Office in Interference No. 96,500 was extended several times beginning in 1969, and eventually terminated on November 2, 1970. However, 3M has petitioned the Patent Office to suspend proceedings pending decision by this Court on this appeal and in any event, the Patent Office could set a special testimony period subsequent to November 2, 1970 if it believed such action warranted.

delivered to Jones' counsel of record in the Interference, to ICI in England and to ICI America, Inc., a Delaware Corporation, doing business in New Jersey.[4] Upon defendant's motions to dismiss the action for lack of personal jurisdiction, District Judge Reynier J. Wortendyke dismissed the discovery proceedings because neither defendant Jones nor defendant ICI was "residing or . . . within" the District of New Jersey and such District was not the one "wherein testimony is to be taken."

The authority of a district court to order discovery in patent interference is conferred by 35 U.S.C. § 24:

> "The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district. . . . The provision of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office."

Defendants argue in effect that personal jurisdiction in a patent interference discovery matter exists only when the first sentence of § 24 is applicable.[5] This reading of the statute would effectively remove non-resident aliens from

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[4] ICI America, Inc. is a subsidiary of ICI. Affidavits filed in the District Court by the Assistant Secretary of ICI indicate that ICI America is a separate entity from ICI, and has no interest in the Patent Interferences here. It is unclear whether the District Court accepted the substance of these affidavits. But because ICI America's existence has no relevance to our decision in this case, no further reference will be made to it.

[5] There is no question that subject-matter jurisdiction is conferred by § 24 and that venue is proper in New Jersey under 28 U.S.C. § 1391(d), providing that [a]n alien may be sued in any district."

the reach of discovery since no district of a United States court extends to foreign countries. However, we believe such a reading misapprehends the basic nature of § 24 discovery—namely, that it is ancillary to the proceedings in the Patent Office.[6] The Tenth Circuit has ably explained the meaning of the "ancillary" concept in the § 24 context:

> "The first sentence of § 24 authorizes the initiation of the ancillary court proceedings by the issuance of a subpoena. The second sentence extends the application of the civil rules pertaining to the production of documents to Patent Office proceedings. The generality of the second sentence is not restricted by the particularity of the first. The contention that jurisdiction is not obtained until a subpoena is issued and that only then may a Rule 34 motion be presented glorifies form over substance. Such formalistic procedure performs no useful purpose . . . [T]he Rule 34 requirement of a 'pending' action is satisfied by the pendency of the interference proceedings. The judicial relief sought is ancillary to the administrative proceedings and is a continuation of the controversy pending before the agency." Natta v. Hogan, 392 F.2d 686, 690 (10th Cir. 1968).

Personal jurisdiction, therefore, is acquired when the parties file interference applications in the Patent Office. The resulting "interference" in the Patent Office is the primary proceeding. A motion for discovery *of documents* under Fed. R. Civ. P. 35, being necessarily limited to a *party* in the action already commenced in the Patent Office, requires no new or independent assertion of personal jurisdiction or issuance of summons. *See* In re Natta, 388 F.2d 215, 220 (3rd Cir. 1968); *Natta* v. *Hogan, supra*

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[6] *See generally* Babcock & Wilcox Co. v. Combustion Engineering Inc., 314 F. Supp. 235, 237 (D. Conn. 1970).

at 691.[7] A very different problem would be presented if a party sought to compel the attendance of a witness through the use of a subpoena under Fed. R. Civ. P. 45. In such a case, the limitations of the first sentence of § 24 would appear to apply. *See In re Natta, supra* at 217.

If the requirements of personal jurisdiction over a party are met by a filing in the Patent Office, the only remaining question is whether service of the Rule 34 motion satisfied the requirements of due process. The notice given in this case was not only to defendants' attorney of record in the Patent Office, but also to defendants directly by mail. Such notices were both reasonable and adequate.

We recognize that our holding means that when a non-resident alien is a party to a patent interference, the other party may seek discovery of documents from him in any district. Such apparent anomaly does not result essentially from the ancillary nature of the discovery proceedings alone, but is also a consequence of the venue statute applicable to aliens. Under 28 U.S.C. § 1391(e), "[a]n alien may be sued in any district." But an alien undoubtedly may move for a change in venue to a more convenient forum. When both parties to the patent interference are United States citizens, the more restrictive provisions of 28 U.S.C. §§ 1391(b) and (c) reduce the number of districts available for discovery. It is these venue provisions which probably explain the location of the various Natta cases in which the alien party was seeking discovery against three domestic corporations.[8]

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[7] No Constitutional problem would appear to exist in granting United States courts personal jurisdiction for purposes of ordering discovery of documents over parties who have filed applications for patents in the Patent Office and thereby sought the protection and benefits of the United States patent law. *Compare* International Shoe Co. v. State of Washington, 326 U.S. 310, 320 (1945) *with Hanson v. Denckla*, 357 U.S. 235, 250-253 (1958). Our reading of § 24 does not imply that the Federal Rules of Civil Procedure create personal jurisdiction here. Rather, those Rules apply only to pre-existing jurisdiction which arises in the Patent Office, and to which this discovery is ancillary.

[8] See note 1, supra.

Defendants raise many substantive objections to the scope and nature of the discovery sought by 3M. These matters, however, should be presented in the first instance to the District Court which has not yet had an opportunity to rule on them.

Accordingly, the judgment of the District Court will be reversed and the case remanded for further proceedings.

A True Copy:

Teste:

Clerk of the United States Court of Appeals for the Third Circuit.

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 19,374 and 19,375

HERWARD A. VOGEL and MINNESOTA MINING AND MANUFACTURING COMPANY, a corporation of Delaware

v.

MICHAEL EDWARD BENET JONES and IMPERIAL CHEMICAL INDUSTRIES LIMITED, a corporation of Great Britain

HERWARD A. VOGEL, Appellant in No. 19,374

MINNESOTA MINING AND MANUFACTURING COMPANY, a corporation of Delaware, Appellant in No. 19,375

(D. C. Civil Action No. 1059-70)

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE ..... DISTRICT OF NEW JERSEY

Present: SEITZ, ADAMS and ROSENN, *Circuit Judges.*

Judgment

This cause came on to be heard on the record from the United States District Court for the ..... District of New Jersey and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court, filed October 1970, be, and the same is hereby reversed, and the cause remanded for further proceedings, in accordance with the opinion of this Court. Costs taxed against appellees.

ATTEST:
THOMAS F. QUINN,
Clerk

May 17, 1971

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 19,374/5

HERWARD A. VOGEL and MINNESOTA MINING AND MANUFACTURING COMPANY, a corporation of Delaware

v.

MICHAEL EDWARD BENET JONES and IMPERIAL CHEMICAL INDUSTRIES LIMITED, a corporation of Great Britain

HERWARD A. VOGEL, Appellant in No. 19,374

MINNESOTA MINING AND MANUFACTURING COMPANY, a corporation of Delaware, Appellant in No. 19,375

SUR PETITION FOR REHEARING

Present: SEITZ, *Chief Judge* and HASTIE, VAN DUSEN, ALDISERT, ADAMS, GIBBONS and ROSENN, *Circuit Judges.*

The petition for rehearing filed by Appellees in the above entitled case having been submitted to the judges who participated in the decision of this court and to all the other available circuit judges of the circuit in regular active service, and no judge who concurred in the decision having asked for hearing, and a majority of the circuit judges of the circuit in regular active service not having voted for

rehearing by the court in banc, the petition for rehearing is denied, and ordered that the mandate shall issue forthwith.

By the Court,
ARLEN R. ADAMS
Judge

Dated: 6/28/71

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 19,374 and 19,375

HERWARD A. VOGEL and MINNESOTA MINING AND MANUFACTURING COMPANY, a corporation of Delaware

v.

MICHAEL EDWARD BENET JONES and IMPERIAL CHEMICAL INDUSTRIES LIMITED, a corporation of Great Britain

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Judgment

This cause came on to be heard on the record from the United States District Court for the ..... District of New Jersey and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court, filed October 20, 1970, be, and the same is hereby reversed, and the cause remanded for further pro-

ceedings, in accordance with the opinion of this Court. Costs taxed against appellees.

ATTEST:
THOMAS F. QUINN,
Clerk

May 17, 1971

COPY

Certified as a true copy and issued in lieu of a formal mandate on June 28, 1971.

Test: THOMAS F. QUINN
Clerk,
United States Court of Appeals
for the Third Circuit

UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY

Civil Action No. 1059-70

HERWARD A. VOGEL and MINNESOTA MINING AND MANUFACTURING COMPANY, a corporation of Delaware,
Petitioner-Respondents,

v.

MICHAEL EDWARD BENET JONES and IMPERIAL CHEMICAL INDUSTRIES LIMITED, a corporation of Great Britain,
Movant-Respondents.

Order

This matter coming on before this Court on October 16, 1970, on the motion of Shanley & Fisher, Esqs., attorneys for the movant-respondents Michael Edward Benet Jones and Imperial Chemical Industries Limited, a corporation of Great Britain, for an Order dismissing this proceeding for lack of jurisdiction in this Court, and Lum, Biunno and Tompkins, Esqs., attorneys for the petitioner-respondents Herward A. Vogel and Minnesota Mining and Manufac-

turing Company, a corporation of Delaware, appearing in opposition thereto;

And it appearing that this Court is without jurisdiction, under 35 U.S.C. § 24, over the movants herein, since neither of the movants is "residing or being within such district", both being subjects of and residing in Great Britain; and this not being the "district wherein testimony is to be taken",

It is, therefore, on this 20th day of October, 1970,

ORDERED that the motion for discovery pursuant to Rule 34 be denied and this proceeding be and hereby is dismissed.

/s/ REYNIER J. WORTENDYKE, JR.
Reynier J. Wortendyke, Jr.
United States Senior
District Judge

STATUTES

Title 35 United States Code

§ 104. Invention made abroad

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

§ 119. Benefit of earlier filing date in foreign country; right of priority

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

In like manner and subject to the same conditions and requirements, the right provided in this section may be

based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority. (Amended October 3, 1961, Public Law 87-333, sec. 1, 75 Stat. 748.)

§ 146. Civil action in case of interference

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons

against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

§ 293. Nonresident patentee; service and notice

Every patentee not residing in the United States may file in the Patent Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

SUPREME COURT, U. S.

Supreme Court, U.S.
FILED
OCT [illegible] 1971
E. R[illegible]K

IN THE

Supreme Court of the United States

No. 71-441

MICHAEL EDWARD BENET JONES and
IMPERIAL CHEMICAL INDUSTRIES LIMITED, *Petitioners,*

v.

HERWARD A. VOGEL and MINNESOTA MINING AND
MANUFACTURING COMPANY, *Respondents*

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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Oct. 25, 1971

IN THE

Supreme Court of the United States

No. 71-441

MICHAEL EDWARD BENET JONES and
IMPERIAL CHEMICAL INDUSTRIES LIMITED, *Petitioners,*

v.

HERWARD A. VOGEL and MINNESOTA MINING AND
MANUFACTURING COMPANY, *Respondents*

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

Had petitioners only stated with accuracy the jurisdictional principles essential to a ready and adequate understanding of the points on which they seek this Court's consideration, petitioners themselves would have seen that this case presents no warrant for grant of a writ.

In bringing their question here concerning jurisdiction of U.S. District Courts to order discovery under 35 U.S.C. §24, petitioners choose to ignore what the Third Circuit Court of

Appeals, in the decision complained of, held to be "the basic nature of Section 24 discovery—namely that it is *ancillary* to the proceedings in the Patent Office." (4a.)*

So far do petitioners stray from the essential point at hand that nowhere is the term "ancillary" to be found in their Petition. The Petition, therefore, should be denied out of hand for lack of compliance with Court Rule 23(4).

Moreover, had petitioners but come to grips with the ancillary nature of jurisdiction in actions under 35 U.S.C. §24, their concern for collision of the decision below, with decisions of this Court setting "minimum contact" standards as a jurisdictional prerequisite over aliens, would have quickly dissolved. Ancillary jurisdiction already subsisted when this suit was brought. *Henry C. Rouse v. Annie Letcher,* 156 U.S. 47 (1895); *Stephen W. Carey v. Houston & Texas Central R. Co.,* 161 U.S. 115 (1896). As this Court stated in *Carey,* quoting from its earlier decision in *Rouse*—

> ". . . where jurisdiction would not obtain in an independent suit, an intervening proceeding may nevertheless be maintained as *ancillary* and supplemental *under jurisdiction already subsisting* . . ." [161 U.S. at 129.]

The decision of the Court of Appeals below is fully consistent with this long settled principle of ancillary jurisdiction. The Opinion carefully explains the basis upon which the United States District Court for the District of New Jersey possessed jurisdiction over petitioners, though aliens (4a):

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* Numerical references with letter suffix are to the appendix to the Petition. Emphasis and matter in brackets supplied throughout unless otherwise noted.

> "Personal jurisdiction, therefore, is acquired when the parties file interference applications in the Patent Office. The resulting 'interference' in the Patent Office is the primary proceeding. A motion for discovery of *documents* under Fed. R. Civ. P. 35 [sic], being necessarily limited to a *party* in the action already commenced in the Patent Office, requires no new or independent assertion of personal jurisdiction or issuance of summons. See *In re Natta,* 388 F. 2d 215, 220 (3rd Cir. 1968); *Natta v. Hogan,* supra at 691." [Emphasis by the Court.]

The ancillary jurisdiction found by the Court of Appeals below is no different, just because an alien litigant is involved, than that uniformly determined to exist in the numerous other Section 24 proceedings which have come before several of the Courts of Appeals. *In re Natta,* 388 F. 2d 215, 220 (3 Cir., 1968), cert. denied, *Montecatini Edison, S.P.A. et al v. E. I. duPont de Nemours & Co.,* 396 U.S. 836 (1969); *Natta et al v. Hogan et al,* 392 F. 2d 686, 690 (10 Cir., 1968); *Natta et al v. Zletz et al,* 379 F. 2d 615 (7 Cir., 1967), cert. denied, *Natta et al v. Zletz et al,* 395 U.S. 909 (1969). That is, those seeking the beneficence of the U. S. patent laws in the primary proceedings must, when called upon, submit to ancillary discovery in the interest of insuring "that the fundamental elements of procedural and substantive due process will be accorded to parties to patent interferences". *In re Natta,* supra, cert. denied, 396 U.S. 836.

Decision below not in conflict with decisions of this Court

Had petitioners only recognized the *ancillary* nature of the jurisdiction, they would have seen that the decision of the Court of Appeals below is not in conflict with this Court's decisions in *Hanson v. Denckla*, 357 U.S. 235 (1958), and *International Shoe Co. v. State of Washington*, 326 U.S. 310 (1945). Both of these decisions deal with due process requirements for *original* in personam jurisdiction of state courts over corporations of sister states. However, as the Court of Appeals below correctly recognized in expressly considering and reconciling *Hanson* and *International Shoe* (5a, note 7)—

> "Our reading of §24 does not imply that the Federal Rules of Civil Procedure create personal jurisdiction here. Rather, those Rules apply only to pre-existing jurisdiction which arises in the Patent Office, and to which this discovery is ancillary."

Decision below not in conflict with statutes

Contrary to petitioners' assertions the decision below is not in conflict with 35 USC §§146 and 293. Neither of these sections applies to proceedings ancillary to *pending* United States Patent Office proceedings. Section 146 deals only with *Court review* of decisions of the Patent Office Board of Patent Interferences on the question of priority (12a); and Section 293 relates to proceedings affecting the issued *patents* of non-resident patentees, *after* patent office proceedings have ended (13a).

If a corresponding statute provided specially for jurisdiction over aliens only in certain District Courts in discovery proceedings ancillary to *pending* Patent Office interferences,

then, of course, such statute would govern the proceedings here involved; but none exists. Hence, general jurisdictional statutes govern, and application of settled principles of general ancillary jurisdiction cannot conflict with special statutes not here involved.

Assertion of conflict between Federal law and decision below is afterthought.

The "conflicts" with decisions of this Court and with Acts of Congress, which petitioners now find, are born of petitioners' having lost in the Court of Appeals. Thus, until the Court of Appeals itself called attention to this Court's decision in *Hanson v. Denckla, supra,* and *International Shoe Co., supra* (5a, note 7), petitioners saw no need to cite these cases in either of the courts below as having any bearing on the instant litigation.

And it is plain why petitioners did not earlier advance their argument based on 35 U.S.C. §§146 and 293. Such an argument would, of course, acknowledge jurisdiction properly residing in the District of Columbia, whereas petitioners were striving to escape the discovery order of any and every court. As the Court of Appeals noted (3a):

> "[Petitioners'] reading of the statute would effectively remove non-resident aliens from the reach of discovery since no district of a United States court extends to foreign countries."

If they mounted an argument below postulating jurisdiction in the District of Columbia court, petitioners knew the discovery suit would wind up there. For as respondents had briefed the Court below:

> "Had [petitioners] ICI but suggested another district, [respondents] 3M would happily have cooperated to bring the matter before the court there."

It was only after the Court of Appeals below found ancillary jurisdiction to subsist in the New Jersey District Court that petitioners saw nothing to lose by their belated argument founded on the District of Columbia being the only appropriate forum.

Harm petitioners fear as consequence of decision below does not exist.

Great mischief will result from the decision below—petitioners say (Pet. 11)—because ancillary actions under 35 U.S.C. §24 against aliens will place an "unnecessary burden on all district courts throughout the land". The problem petitioners raise, were there any, "does not result essentially from the ancillary nature of discovery proceedings" under Section 24 (5a), but is instead attributable to the venue statute applicable to aliens, who, under 28 U.S.C. §1391(d), "may be sued in any district". Moreover, the Court of Appeals foresaw and in one sentence resolved any "far-reaching consequences" of its decision which petitioners would find (5a):

> "But an alien undoubtedly may move for a change in venue to a more convenient forum."

CONCLUSION

For the reasons stated above, it is submitted that the petition overlooks the very basis of jurisdiction found by the Court of Appeals below, and, moreover, raises no special and important question of law requiring resolution by this Court.

The petition should be denied.

Respectfully submitted,

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Oct. 25, 1971